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10/524,014	02/08/2005	Aurelio Romeo	5059-0102PUS1	7574
2292	7590	01/11/2008	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			MAHAFKEY, KELLY J	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			1794	
			NOTIFICATION DATE	DELIVERY MODE
			01/11/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/524,014

Applicant(s)

ROMEO, AURELIO

Examiner

Kelly Mahafkey

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24,25,27-32,35 and 37-74 is/are pending in the application.
- 4a) Of the above claim(s) 57-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24,25,27-32,35, 37-56, and 69-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Amendments made 10/17/07 have been entered.
Claims 24, 25, 27-32, 35, and 37-74 are pending.
Claims 57-68 are withdrawn.

Specification

The previous objection to the specification has been withdrawn in light of applicant's amendments made 10/17/07.

Claim Rejections - 35 USC § 112

The previous 112 1st and 2nd Paragraph rejections have been withdrawn in light of applicant's amendments made 10/17/07.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 24, 25, 27-30, 35, 37-44, 69, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809) in view of Tanglertpaibul (XP 002043494). The references and rejection are incorporated herein and as cited in the office action mailed May 17, 2007. Specifically regarding claim 35, Glasser teaches, in Example 2, that the composition includes about 8% oil. Glasser teaches, Column 4 lines 3-8, that ingredients, such as oil, can be added to provide desired texture and flavor appeal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the 8% oil as taught by Glasser depending on the desired texture and flavor of the final product. Specifically regarding the newly added claim 69, Glasser teaches, in Example 2, that vegetable paste, which includes tomato paste and juices, is included in the soup composition. Specifically regarding newly added claim 70, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the vegetables in the most convenient form, i.e. as puree, as juice, as passata. To include the vegetable in different forms and to adjust

the solids content as appropriate would only require routine experimentation of one of ordinary skill in the art and would not impart a patentable distinction to the claims.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809) in view of the Benefits ("The Benefits of Olive Oil"). The references and rejection are incorporated herein and as cited in the office action mailed November 11, 2006.

Claims 32, 73, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809), in view of Terrytx (Creamy Tomato Cheese Soup, 1999 Recipelink.com). The references and rejection are incorporated herein and as cited in the office action mailed November 11, 2006. Regarding newly added claims 73 and 74, Glasser teaches that additional ingredients can be added into the tomato composition depending on the desired flavor and texture of the final product (Column 4 lines 3-8 and Column 6 lines 37-42). Terrytx teaches of a soup composition that includes low fat soft cheese. Terrytx teaches that the soup, which includes cheese, is a good soup. Thus, it was known at the time the invention was made to include soft cheeses in soups. It would have been obvious to include a soft cheese in the soup as taught by Glasser depending on the desired final flavor of the soup (i.e. tomato or tomato and cheese, ect). One would have been motivated to use a specific amount of cheese depending on the desired intensity of the cheese flavor in the final product.

Claims 24, 25, 45-56, 71, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bueno (EP 0888718 A1). The references and rejection are incorporated herein and as cited in the office action mailed May 17, 2007. Specifically regarding claim 71, as previously stated Bueno teaches of a tomato product prepared from tomatoes which contain tomato juice. Specifically regarding claim 72, Due to the optional limitations recited in claim 45, tomato passata (the current option) recited in dependent claim 72 is not a required limitation, and thus claim 72 is also included in the rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., cheese as incorporated into the soup product, the amount of particles macerated to a diameter of less than 0.15mm, the chemical composition of the tomato product) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Specifically regarding the addition of cheese, applicant's claims recite that the tomato composition includes cheese; applicant's claims do not recite the degree of bending or the method in which the cheese is blend with the tomato product. As the reference of record, Bueno, teach combining a tomato product with a cheese product, to form a final tomato product, the reference of record read upon the instantly claimed invention. Specifically regarding the maceration amount, applicant's claims recite that particles are macerated to a diameter of less than 0.15mm; applicant's claims do not recite that all of the particles are macerated to a diameter of less than 0.15m. As the reference of record, Bueno, teach that 20% of the particles are macerated to a diameter of less than 0.15mm, the reference of record read upon the instantly claimed invention.

Response to Arguments

Applicant's arguments filed 10/17/07 have been fully considered but they are not persuasive.

Applicant argues that the weight percentages of the insoluble and soluble solids as taught by Glasser are "significantly different" then those of the claimed invention and thus are "outside the scope" of the present invention. Applicant's argument is not convincing as the instantly claimed invention recites 18-30% or 20-30% water insoluble solids and 80-94.5% or 70-80% water soluble solids; as Glasser teaches 33.33% insoluble solids (as stated in the previous office action and as calculated in applicant's arguments page 23) and 66.67% water soluble solids (as stated in the previous office action and as calculated in applicant's arguments page 23); and as Tanglertpaibul

teaches motivation for modifying the amount of water soluble and insoluble solids (as stated in the previous office action). Where the claimed and prior art products are substantially identical in structure or composition, a prima facie case of obviousness has been established, absent any clear and convincing evidence to the contrary. At the current time Glasser teaches of a substantially identical product to that as instantly claimed and no such evidence has been provided showing otherwise. Applicant has not provided any evidence to show that a difference of 3% in the insoluble and soluble solids leads to unexpected properties in the claimed product. Furthermore, as stated above, it would have been obvious to one skilled in the art to adjust the water insoluble solids and water soluble solids when desiring specific properties as taught by Tanlertpaibul and to do so would have been well within the skill of one in the art.

Applicant argues that the Glasser does not teach of 5.5-20% dry residue or 94.5-80% water. Applicant's argument is not convincing as applicant's argument is based on the teachings of Glasser in relation to the soup concentrate and not on the teachings of the final soup product as discussed in the Glasser reference and in the previous office action, in which Glasser teaches of 85-96% water and 4-15% solid/dry residue.

Applicant argues that the Glasser reference teach of vegetable compositions and not a tomato composition. Applicant's argument is not convincing as Glasser teaches of vegetable compositions and then teaches, in Example 2, that tomato is a vegetable of the invention. Glasser teaches, in Example 2, that vegetable paste, which includes tomato paste and juices, is included in the soup composition.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant argues that the water soluble matter measured by calculations as taught by Bueno is not an accurate representative of the amount of water soluble matter in the composition applicant refers to Exhibits 5 and 6 to support this argument. At the present time, applicant has not provided or has not identified a submitted "exhibit 5" or "exhibit 6", thus at that current time applicant's argument is not convincing.

Applicant's arguments filed 10/17/07 have been fully considered but they are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Group 1700

Kelly Mahafkey
Examiner
Art Unit 1794

A handwritten signature in black ink, appearing to be 'KM', with a large, sweeping loop at the end.